

REMARKS

This amendment is in response to the incomplete second Office action and the Requirement for Restriction under 35 U.S.C. § 121 set forth in that action.

Status of the claims

Claims 1-9 and 11-21 remain pending. Claims 3 and 16 are amended to broaden their scope of coverage.

Requirement for Restriction

In Paper No. 20050524, the Examiner imposed a requirement under 35 U.S.C. §121 and 37 CFR § 1.142, for restriction between:

- Group I covered by claims 1-6, and 11-18, drawn to a container, classified in class 229 at subclass 198;
- Group II covered by claims 7-10, drawn to a method of making a crate, classified in class 493 at subclass 84.

The Applicant provisionally elects, with traverse, the subject matter of Group I. Claims 1-9 and 11-21 are believed to read upon the elected group. In support of the Requirement for Restriction, the Examiner asserted that:

“The product as claimed can be made by other methods, the sewing can be done by hand, or before the application of adhesive as set forth in claims 7, 8, or 9.”

The Examiner’s reasoning is spacious, because this reasoning ignores the language of the pending claims, improperly delivers to read features into the claims from depending claims, and provides no showing that either the process as claimed can be used to make other materially

different products or that the product as claimed can be made by another materially different process, as is required under § 806.05(f) of the *Manual Patent Examining Procedure*, (Eighth Edition, Revision 2). Consequently, the Examiner has failed to justify the belated imposition of a Requirement for Restriction after examining all claims upon the merits. By way of example, neither independent apparatus claim 1 nor independent process claim 7 negates either the practice of these intentions where (i) sewing may be done by hand or (ii) that the sewing may be done before the application of an adhesive. It is wholly impermissible for the Examiner to read features of dependent claims into these independent claims.

Secondly, the Examiner has made no showing of “a serious burden if a restriction is not required.” The Examiner’s intension is invited to § 811 of the *Manual*.

In view of forgoing, the Examiner has failed to make any showing that the inventions are distinct from each other, and has failed to meet the requirement of a showing of a serious burden as is required by § 811 of the *Manual*. Withdrawal of the Requirement is therefore mandated.

Forgoing is incomplete under 37 CFR § 1.104, because the Examiner has not addressed the canceled claim 10 or previously presented claims 19-21. This incompleteness unnecessarily and unfairly prolongs the examination, at great expense and inconvenience to the Applicant. Discontinuance of unnecessary requirements is therefore respectfully urged.

Every other forgoing amendments are on merits, this application is deemed to be in condition for allowance of all pending claims. Such action is respectfully requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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